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APR 11 2008

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In re Application of :
CHEN :Decision on Petition
Serial No.: 10/723,955 :
Filed : 26 November 2003 :
Attorney Docket No.: AREN-007CON2(7.US29.CON)

This letter is in response to the Renewed Petition under 37 C.F.R. 1.181 filed on 6 March 2008 requesting consideration of the Examiner's communication mailed 28 February 2008.

BACKGROUND

This application is filed under 35 USC 111(a) and, as such, is subject to restriction requirement per MPEP Chapter 800.

On 10 October 2006, the examiner mailed a requirement for restriction among 4 groups.

On 2 February 2007, applicants elected Group III with traverse and requested that Group III be joined with Group IV for examination.

On 9 May 2007, the examiner considered the traversal and rejoined Groups III and IV together for examination on the merits.

On 5 November 2007, applicants responded to the Office action by cancelling all pending claims and by adding new claims 69-87.

On 28 February 2008, the examiner sent out a communication which stated that the amendment was non-responsive under MPEP 821.03 because the examiner reasoned, the amendment cancelled all cancelling all claims directed to the elected invention.

On 6 March 2008, applicants filed this petition.

DISCUSSION

The file history and petition have been considered carefully. The invention which has been examined in the first Office action on the merits is described by the examiner as Groups III and IV[1] in the restriction requirement as follows:

III. Claims 33-35, drawn to method of using a G protein-coupled receptor of SEQ ID NO:82 to screen candidate compounds as pharmaceutical agents for a disease or disorder ameliorated by an elevation of an intracellular level of cAMP in peripheral blood leukocytes, classified in class 435, subclass 7.1.

IV. Claims 51-59, drawn to a method for identifying one or more candidate compounds as a modulator of a non- endogenous, constitutively activated version of a G protein-coupled receptor, wherein said receptor comprises an amino acid sequence of SEQ ID NO:82 that comprises a substitution of an amino acid other than an isoleucine for the isoleucine at position 225 of said amino acid sequence., classified in class 435, subclass 7.1.

The invention which has been examined in the first Office action on the merits has been claimed as follows:

[1] The examined rejoined Groups III and IV for concurrent examination on the merits in the Office action dated 9 May 2007.

33. **(Now cancelled)** A screening method for identifying a compound as a pharmaceutical agent for the treatment of a disease or disorder ameliorated increasing intracellular level of cAMP in peripheral blood leukocytes, said method comprising:

(a) contacting a candidate compound with a host cell or membrane thereof that comprises a G protein-coupled receptor (GPCR), wherein said GPCR comprises an amino acid sequence that is at least 80% identical to the amino acid sequence of SEQ ID NO:82; and

(b) measuring the ability of the compound to act as an agonist or partial agonist of the GPCR;

wherein an ability to act as an agonist or partial agonist of the GPCR indicates that the compound can be employed as a pharmaceutical agent for the treatment of said disease or disorder.

51. (New) A method for identifying one or more candidate compounds as a modulator of a non-endogenous, constitutively activated version of a G protein-coupled receptor, said method comprising the steps of:

(i) contacting said one or more candidate compounds with a host cell or with membrane of a host cell that expresses said receptor; and

(ii) measuring the ability of the compound or compounds to inhibit or stimulate functionality of the receptor,

wherein said receptor comprises an amino acid sequence of SEQ ID NO:82 that comprises a substitution of an amino acid other than an isoleucine for the isoleucine at position 225 of said amino acid sequence.

The independent claim submitted on 5 November 2007 stated:

69. (New) A method of screening for a compound that increases cAMP levels in peripheral blood leukocytes, comprising:

(a) contacting a candidate compound with a G protein-coupled receptor (GPCR) that is present on the surface of a recombinant host cell or isolated membrane thereof, wherein said GPCR comprises an amino acid sequence that is at least 80% identical to the amino acid sequence of SEQ ID NO:82;

(b) determining if said candidate compound is an agonist of said GPCR; and

(c) determining if said agonist increases cAMP levels in a peripheral blood leukocyte.

The examiner reasoned that the new claims are not directed to the same invention as Group III/IV because the new claims do not screen for candidate compounds a pharmaceutical agents for as a disease or disorder ameliorated by an elevation of an intracellular level of cAMP in peripheral blood.

The examiners reasons are not commensurate in scope with the claims. Neither new claim 69 nor previously examined Claim 51 required the limitation of "screening for candidate compounds a pharmaceutical agents for a disease or disorder ameliorated by an elevation of an intracellular level of cAMP in peripheral blood."

New claim 69 contains active steps comparable to claims 33 and 51. New Claim 69 encompasses the same embodiment as claims which had previously been examined. As stated in MPEP 806.03,

> Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Because of these similarities, Claim 66 is not considered distinct from claim 33 or 51. For these reasons, the amendment filed 5 November 2007 is considered responsive and will be entered into the file.

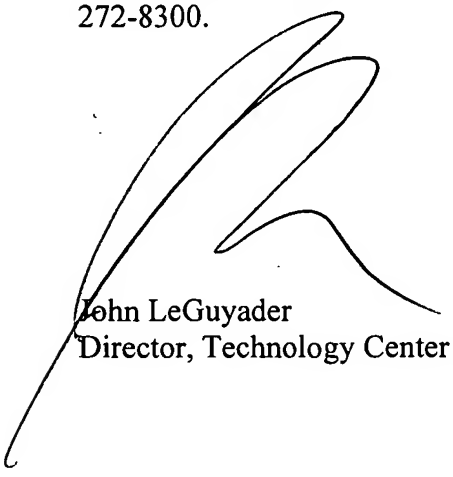
DECISION

The petition filed under 37 CFR 1.181 on 6 March 2008 is **GRANTED**.

The amendment filed 5 November 2007 will be entered.

The application will be forwarded to the examiner to consider the papers filed 5 November 2007 and to prepare an Office action consistent with this petition decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.



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